

REMARKS

This Amendment and Request for Reconsideration is filed in response to the Office Action of 23 August 2005. The present Amendment amends claims 1, 3-7, 8, 10-12, 13, 25, 32, 33, 36, 38, 40, 41, 44, 45, and 46. No new matter has been entered; all amendments and new claim language is fully supported by the application as originally filed. The Applicant respectfully requests entry of the present Amendment and reconsideration of all claims as amended.

In the Office Action of 23 August 2005, the Examiner allowed claims 39-43 and indicated the allowability of objected claims 45-47 merely as being dependent upon a rejected base claim. In response, the Applicant respectfully acknowledges the Examiner's assessment of these claims and submits that the present invention defined by such claims should be provided with a broad scope of coverage as warranted by law. Regarding claims 44-50 specifically, the Applicant has amended independent claim 44 to include all limitations of previous claim 45 which has been indicated to be allowable. Therefore, all claims 44-50 as amended as well as claims 39-43 are allowable.

In the Office Action of 23 August 2005, the Examiner rejected other claims of the patent application under 35 U.S.C. Sect. 103(a) based on U.S. Patent No. 5,613,213 to Naddell et al. in combination with other references such as U.S. Patent No. 6,625,451 to La Medica, Jr. et al., U.S. Patent No. 6,603,755 to Parker, and U.S. Patent Application Publication No. US2002/0039892. In response, the Applicants respectfully disagree and submit that all claims as amended are allowable over the prior art of record for at least the following reasons.

For rejections under 35 U.S.C. Sects. 102 and 103, the prior art (individually or in combination) must teach or suggest each and every limitation in the claims. Referring specifically to amended claim 1, the cited documents (alone or in combination) do not teach or suggest the act of "determining which communication networks make a data communication service available to the mobile communication device *based on an*

attempt to access the data communication service through each communication network”.

As apparent, the invention as defined by at least some of the revised claims is directed to mobile station techniques for preferentially selecting networks that make a *data communication service* available where data service availability is determined based on actual attempts to access the data service through these networks. The prior art does not teach or suggest such techniques. For example, Naddell et al. teach a technique for displaying services associated with various communication systems so that an end user may choose which system to utilize. The services of each communication system are obtained based only on status indicators transmitted from the system. As one ordinarily skilled in the art may appreciate, even though a status indicator may indicate that a service is made available by a communication system, *a mobile communication device may still not be granted access to that service by the communication system*. In Naddell et al., no teaching or suggestion of making attempts to access the communication service in the communication system to identify whether the service is actually made available exists. In fact, Naddell et al. teach away from such technique (see e.g. col. 4 at lines 55-57: “communication unit 108 may then display an indication of the associated services under the assumption that these are all available at the time”). As another example, PCT Publication WO 01/47316 A2 teaches network selection based on system features as well as system identification, but relies on pre-programming a mobile station’s database in accordance with predetermined system attributes. Through programming, the service provider or network side controls the preferences of the mobile station which otherwise operates utilizing a generic algorithm.

According to the present application, a mobile station gains such data service availability “knowledge” at least in part through its own actual “experience” in connecting with the networks. See e.g. page 23 at lines 31-33 through page 24 at lines 1-28, and page 25 at lines 21-22. This is advantageous, as real-time knowledge of the availability of network services may otherwise be difficult to obtain. The mobile station is the entity that maintains network selection control and has a fixed bias for

preferentially selecting those networks that actually make the data communication service available to it. Similar limitations of claim 1 are recited in independent claims 8, 13 and 38.


Other claim limitations are also not taught or suggested by the prior art. For example, some of the claims of the present application are specifically directed to the use of a priority list or network selection list in an automatic network selection technique of the mobile communication device. See e.g. claims 6, 12, 33, and 38. In contrast, Naddell et al. is directed specifically to the *display* of communication services of the communication systems for an *end user's choice*. The present invention as defined by claims 6, 12, 33, and 38 relates to use of a network selection list for use in an automatic network selection technique in which the mobile communication device itself selects the communication network that is best for the device. The term "automatic network selection" is a term of art which one ordinarily skilled in the art will readily appreciate. Any attempt to combine Naddell et al. with a teaching or suggestion for automatic network selection would defeat the primary purpose of the teachings of Naddell et al., which is to provide the user with a *display* of all services for the *end user's choice*.

Based on the above, the Applicant respectfully requests the Examiner to withdraw all Section 103 rejections and allow all claims 1-50. The Applicant respectfully submits that the present application is now in a condition suitable for allowance based on the claim amendments and arguments presented herein.

Thank you. The Examiner is welcome to contact the undersigned if necessary to expedite prosecution of the present application.

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Respectfully submitted,



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